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James T. Carter
640 Turk Street, Apt. 4
San Francisco CA 94102

In re Patent No. 6,326,446
Issue Date: December 4, 2001
Application No. 09/735,525
Filed: December 14, 2000
For: MACROPOROUS HYPERHYDROXY
POLYMER AND ARTICLES MADE
THEREFROM

MAILED

SEP 27 2010

OFFICE OF PETITIONS

DECISION ON PETITION
UNDER 37 CFR 1.378(b)

This is a decision on the petition under 37 CFR 1.378(b), filed June 23, 2010, under 37 CFR 1.378(b).

The petition under 37 CFR 1.378(b) for reinstatement of expired patent is hereby **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). **Any such petition for reconsideration must be accompanied by the petition fee of \$400 as set forth in 37 CFR 1.17(f)**. The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

The patent issued December 4, 2001. The second maintenance fee could have been paid from December 4, 2008 through June 4, 2009 without a surcharge, or with a surcharge during the period from June 5, 2009 through December 4, 2009. Accordingly, the patent expired on December 4, 2009 for failure to timely submit the second maintenance fee.

A petition to accept the delayed payment of a maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent, (2) payment of the appropriate maintenance fee; unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1).

This petition lacks item requirement (1) set forth above.

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable". 35 U.S.C. § 41(c)(1).

Patentee appears to attribute the failure to timely pay the second maintenance fee to the death of his attorney, Leonard Sherman, on whom he relied to remind him that the maintenance fee was due.

In this regard, patentee states:

"Mr. (Edwin) Shalloway died around 2002. Mr. (Leonard) Sherman then provided me with timely notice for three maintenance fee payments. Mr. Sherman then died five years later. Their firm closed some time later without notification. With the unavoidable loss of my lawyers and their firm, I missed paying the 5 ½ yr fee two months ago. Finally, a company is interested in licensing my patents, they informed me of the new PAIR site where this morning I discovered my Dec 4, 2009 fee was not paid."

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

Acceptance of late payment of a maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses the identical language, i.e. "unavoidable delay". Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988)). Decisions on reviving abandoned applications have adopted the "reasonably prudent person" standard in determining if the delay in responding to an Office action was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-515 (D.C. Cir. 1912); and Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141. In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

In essence, patentee must show that he was aware of the need to pay the maintenance fee, and to that end was tracking it, or had engaged someone to track it before the expiration, but when the fee came due, was "unavoidably" prevented from making the maintenance fee payment from the time the payment was due until the filing of a grantable petition. Petitioner has failed to meet this burden.

In determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray, 55 F3d at 608-609, 34 USPQ2D at 1787. It is incumbent upon the patent owner to implement steps to schedule and pay the fee, or obligate another to do so. See California Medical Products v. Technol. Med. Prod., 921 F.Supp 1219, 1259 (D. Del. 1995). That is, 37 CFR 1.378(b)(3) requires a showing of the steps in place to pay the maintenance fee, and the record currently lacks a sufficient showing that any steps were emplaced by petitioner or

anyone else. In the absence of a showing that patentee or anyone else was engaged in tracking the maintenance fee due dates, and that party had in fact been tracking the due dates with a reliable tracking system, such as would be used by prudent and careful men in relation to their most important business, petitioner cannot reasonably show that the delay was unavoidable delay. In re Katrapat, 6 USPQ2d 1863, 1867-1868 (Comm'r Pat. 1988); California, supra.

Petitioner has not provided any documentary evidence demonstrating the nature and extent of contractual obligations of Mr. Sherman to establish that Mr. Sherman was contractually bound to track the maintenance fee on behalf of patentee.

It is unclear when petitioner first became aware that the patent expired due to failure to pay the second maintenance fee. Thus, it cannot be found that the instant petition was filed within a reasonable time thereafter.

It is unclear when patentee's attorney died or when the attorney's law firm closed without notification to patentee. When and how did patentee discover that Mr. Sherman had died? Prior to the death of Mr. Sherman, what was the business routine by which patentee was made aware that a maintenance fee was due?

In view of the limited statement provided by patentee, it cannot be determined that the failure to timely submit the required maintenance fee, from the time that the maintenance fee was due until the filing of a grantable petition, was unavoidable.

Ultimately patentee bears the responsibility for timely remittance of the maintenance fee. The petition fails to establish that patentee was unavoidably delayed in making the payment. Accordingly, the Office is precluded from accepting the maintenance fee and surcharge. If reconsideration of this decision is not desired, petitioner may request a refund of this fee by writing to the Finance Office, Refund Section. A copy of this decision should accompany any request for refund.

Any renewed petition must establish that the entire period of delay from the time that the maintenance fee was due until the time of the filing of a grantable petition has been unavoidable. Petitioner is reminded that any renewed petition should entail an exhaustive effort to establish that the failure to timely pay the maintenance fee was unavoidable as after reconsideration pursuant to 37 CFR 1.378(e), no further reconsideration regarding unavoidable delay will be undertaken.

Petitioner must establish that patentee was aware of the need to pay the maintenance fee, and was tracking it, or had engaged someone to track it before the expiration, but when the fee came due, was "unavoidably" prevented from making the maintenance fee payment due until the filing of a grantable petition. Petitioner must establish a nexus between the events complained of and the failure to timely remit the maintenance fee.

Petitioner may wish to submit material such as but not limited to copies of any contractual agreements between the attorney and patentee whereby the attorney was engaged to track the maintenance fee; copies of any reminder letters received from the attorneys to patentee

concerning maintenance fees for the patent; and, a detailed statement concerning the system in place for tracking the maintenance fee.

ALTERNATIVE REMEDY

Patentee may wish to consider filing a petition stating that the entire period of time, from the time that the maintenance fee was due until the filing of a grantable petition, was unintentional in the form of a petition under 37 CFR 1.378(c), copy of which is enclosed as a courtesy. The filing of a petition under 37 CFR 1.378(c) cannot be delayed and must be submitted within 24 months after the six-month grace period provided in § 1.362(e) and must include: (1) the required maintenance fee set forth in § 1.20 (e) through (g); (2) the surcharge set forth in § 1.20(i)(2); and (3) a statement that the delay in payment of the maintenance fee was unintentional. Petitioner is advised that the \$700.00 surcharge submitted with the instant petition could be applied to the surcharge required under 37 CFR 1.378(c)(2) which is currently \$1,640.00.

The requested change of correspondence address has been entered into the record.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

By hand: Customer Service Window
 Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

By fax: (571) 273-8300
 ATTN: Office of Petitions

The requested revocation of power of attorney/change of address has been entered into the record.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3205.

/ALESIA M. BROWN/

Alesia M. Brown
Petitions Attorney
Office of Petitions

Enclosure